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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,894	03/30/2004	Hiroyuki Gennami	5000-5158	7615

7590 02/22/2006
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154

EXAMINER

TRIEU, THERESA

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,894

Applicant(s)

GENNAMI ET AL.

Examiner

Theresa Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 11-16 is/are rejected.
- 7) ☒ Claim(s) 5-10 and 17-22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/26/04, 03/30/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "HORIZONTAL SCROLL COMPRESSOR HAVING A CONECTING PASSAGE ON THE OPPOSITE SIDE OF A SUCTION PORT FOR CONNECTING A MOTOR ACCOMMODATING CHAMBER WITH THE CHAMBER".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 11, 13, 14, 16 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Arata (Publication Number JP 61-053488)

Regarding claims 1, 2, 4, 11, 13, 14, 16 and 23, as shown in Fig. 3, Arata discloses an electric compressor, comprising: an electric motor (7) having an axis of rotation; a compression mechanism (2, 3) that is driven by the electric motor to compress gas, wherein the compression mechanism includes a suction chamber (2a); a housing for accommodating the compression mechanism, wherein the housing defines a motor accommodating chamber (11) that

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accommodates the electric motor such that the rotation axis of the motor is substantially horizontal, and wherein the pressure in the motor accommodating chamber is equal to the pressure in the suction chamber; and a connecting passage (20, 23a, 23) for connecting a bottom portion of the motor accommodating chamber with the suction chamber (2a); the compression mechanism being of a scroll type and includes: a stationary scroll (4) having a base plate and a volute portion, wherein the base plate is fixed to the housing; and a movable scroll (3) having a base plate and a volute portion, wherein the movable scroll, together with the stationary scroll, defines a compression chamber (2c) between the volute portions, wherein the motor causes the movable scroll to orbit so that the compression chamber is moved toward the center of the volute portions while decreasing the volume, whereby gas is compressed; the base plate of the movable scroll having a first face and a second face, the volute portion extending from the first face, and the second face being opposite from the first face (see Fig. 3), wherein a partition member (5) is located in the housing to face the second face, wherein the second face and the partition member define a back pressure chamber (not numbered; however, clearly seen in Fig. 3), wherein an elastic body (1b) is located between the second face and the partition member, the elastic body urging the movable scroll toward the stationary scroll, and wherein the elastic body seals the back pressure chamber and the suction chamber from each other; in the motor accommodating chamber, a recess (not numbered; however, clearly seen in Fig. 3) being formed in a lower part of the housing that is located below the motor (7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arata in view of Yamada et al. (Yamada) (Patent Number 5,468,130).

Arata discloses the invention as recited above; however, Arata fails to disclose the surface of the movable scroll being plated with nickel phosphorus.

Yamada teaches that it is conventional in the art to utilize the movable scroll member being coated with nickel phosphorous. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have utilized the surface of the movable scroll being plated with nickel phosphorus, as taught by Yamada in the Arata apparatus, since the use thereof would have improved the wear resistance.

4. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arata in view of design choice.

Arata discloses the invention as recited above; however, Arata fails to disclose the compressor being used in a vehicle air conditioner. It is examiner's position that one having ordinary skill in the electric scroll compressor art, would have found it obvious to utilize the compressor being used in a vehicle air conditioner, since they are merely design parameters depending on being used for a particular purpose or solving a stated problem. Moreover, there is nothing in the record which establishes that the claimed scroll compressor for a vehicle air conditioner, presents a novel of unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

Allowable Subject Matter

5. Claims 5-10 and 17-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art

The IDS (PTO-1449) filed on March 20, 2004 and August 26, 2004 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and consists of four patents: Suzuki (Publication Number JP 03-206388), Tamura (Publication Number JP 05-086483), Araki (Publication Number JP 2000-213479), and Nojima et al. (Publication Number JP 2001-271752), each further discloses a state of the art.

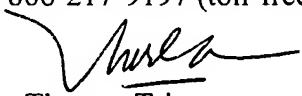
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT
February 14, 2006



Theresa Trieu
Primary Examiner
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